

Appl. No. 10/607,683
Atty. Docket No. 8797R
Amdt. dated June 15, 2006
Reply to Office Action of March 15, 2006
Customer No. 27752

REMARKS

Claim Status

Claims 1, 4-6, and 16-17 are pending in the present application. No additional claims fee is believed to be due.

Claims 2-3, and 7-15 were previously canceled without prejudice.

Claim 1 has been amended to include the transition phrase "consisting of" for certain claimed limitations. Support for this amendment can be found, for example, at page 8, lines 21-29 and with respect to FIG. 1.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §102(e) Over Hirotsu (2004/0102748)

Claims 1, 4-6, 16 and 17 have been rejected under 35 USC §102(e) as being unpatentable over Hirotsu, US 2004/0102748.

Applicants have amended Claim 1, from which all claims depend, to include the transitional phrase "consisting of" with respect to absorbent articles each having the same level of absorbency. Hirotsu discloses a package having absorbent articles having different levels of absorbency. Applicants submit that Claim 1 and its dependent claims is therefore patentably distinct over Hirotsu.

Because Claim 1 has been limited to be patentably distinct over Hirotsu, Applicants respectfully request the 35 USC §102 rejection of Claim 1 and its dependent claims be withdrawn.

Rejection Under 35 USC §103(a) Over Brisebois et al. (U.S. 6,454,095) in view of Hirotsu (2004/0102748)

Claims 1, 4-6, 16 and 17 have been rejected under 35 USC §103(a) as being unpatentable over Brisebois et al. U.S. 6,454,095 in view of Hirotsu U.S. 2004/0102748).

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The Office Action states that Brisebois discloses the claimed limitations "except for the signal being displayed as a distinctive color and the container comprises a first window for revealing at least a portion of the distinctive color of the wrapper."

Hirotsu is provided for its disclosure of a window and the distinctive color of the wrappers.

Applicants submit that the claim limitations not shown by Brisebois are:

1. "said signal [indicating absorbency] being displayed as a distinctive color on said wrapper"; and
2. "a first window in said container"; and
3. "said first window revealing at least a portion of said distinctive color".

Applicants traverse the rejection because the Office Action fails to make a *prima facie* case of obviousness. As the Office Action recognizes, it is basic patent law that the rejection of the present invention under 35 U.S.C. §103 must comport with the standard set forth in *Graham v. John Deere Company* 383 US1, 148 USPQ 459 (1966), explained in MPEP Section 706. The Supreme Court's guidance in that landmark case, requires that, to establish a *prima facie* case of obviousness, the USPTO must:

- (1) Set forth the differences in the claims over the applied references;
- (2) Set forth the proposed modification of the references which would be necessary to arrive at the claimed subject matter; and
- (3) Explain why the proposed modification would be obvious.

With respect to Step (1), Applicants agree with the Office Action that Brisebois fails to disclose the three elements listed above as recited in Claim 1.

Looking to Step (2), the modification to Brisebois necessary to comport with the instant claims is to at least add signals displayed as distinctive colors on the wrapper of absorbent articles, to add a window, and the window revealing at least a portion of the distinctive color.

To satisfy Step (3), the Office Action must identify where the prior art provides a motivating suggestion to make the modification proposed in Step (2). Applicants submit

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that the Office Action has failed to do so. The Office Action simply makes the conclusory statement that "It would have been obvious . . ." (page 4, last paragraph dealing with claim 1). However, the Office Action provides no reason why such a modification is suggested, except for the unsupported conjecture of "convenience to the user". Certainly there is no suggestion in Brisbois of the need or benefit of a window for convenience or any other reason. Brisbois provides no suggestion or motivation for a window, and suggests no desirability of the benefit of seeing product inside. Such a window is totally unnecessary in Brisbois, is not any more "convenient" than what is already disclosed, and could simply add cost of manufacture. Any conjecture as to why the skilled person would wish to modify Brisbois to have a window is just that—conjecture, because Brisbois provides no clue.

Simply knowing about Hirotsu is not enough to combine with Brisbois. CAFC law is clear that simply because a combination can be made is not sufficient to show that the skilled person would be motivated to combine or prompted to modify. There must be some suggestion in the references themselves to make such a modification. The Office Action has not shown where in Brisbois, for example, is found any suggestion to be combined or modified to have a window. This appears to be a clear example of impermissible hindsight.

Accordingly, because the Office Action fails to make a *prima facie* case of obviousness in accordance with MPEP 2143, Applicants respectfully request that the rejection be withdrawn and Claim 1 and its dependent claims be allowed.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 USC 102 and 103. Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 4-6, and 16-17 is respectfully requested.

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Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Signature

Roddy M. Bullock

Typed or Printed Name
Registration No. 37,290
(513) 634-0870

Date: June 15, 2006
Customer No. 27752
(Amendment-Response to Office Action.doc)
Revised 11/18/2005